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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,939	06/14/2005	Erik A. T. Trommelen	A0006/US	5931
30522 7590 04/06/2009 KRATON POLYMERS U.S. LLC WESTHOLLOW TECHNOLOGY CENTER 3333 HIGHWAY 6 SOUTH HOUSTON, TX 77082				
EXAMINER				
SZEKELY, PETER A				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/06/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kratonip@kraton.com

Office Action Summary

Application No.

10/538,939

Applicant(s)

TROMMELEN ET AL.

Examiner

Peter Szekely

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention of a polymer concentration of "more than 30% by weight" in the instant specification. Although applicants' "more than 20% to 50%" concentration range encompasses "more than 30 to 50%", in order to avoid the new matter rejection the claimed amount or range has to be explicitly present in the specification. See *In re Wertheim*, 191 USPQ90 (CCPA 1976). The rejection is maintained in view of the "Response to Arguments" set forth below.

3. Claims 11-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of "a vinyl content in the range of from about 8 to about 23 mole%". Page 6, third paragraph

of the specification only discloses "more preferably from 8 to 25 mole%". There is no "23" and there is no "about". Applicants cannot pick out any number they desire from a previously disclosed range.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 11-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. 4,405,680, Grube et al. 5,055,135, or Ohtsuka et al. 5,925,625, in view of Schoenke et al. 4,032,491, Buck et al. 4,530,652, Kalkanoglu 5,437,932, Fensel et al. 6,524,980, Drieskens et al. 6,538,053 or Stephens et al. 2003/0149140.
6. The rejection is maintained in view of the "Response to Arguments" set forth below.

Response to Arguments

7. Applicant's arguments filed 2/4/09 have been fully considered but they are not persuasive. In the decision of the CCPA of In re Wertheim, the court accepted the claimed range of 35% to 60% because there was a specific example of 36%. Applicants have no comparable example in the instant specification. As far as the secondary references are concerned all of them disclose roofing compositions comprising styrene-butadiene-styrene copolymers and asphalt. They show that using a blend of block copolymers and asphalt for roofing felts is well known and thus obvious. They also show that a wide range of different block copolymers in different concentrations can be used in order to achieve different properties. The composition of

Schoenke et al. has good bond strength, resistance to cracking, tensile strength and cracking (Abstract). Weight reduction is shown in column 4, lines 51-64 making applicants' composition only an optimization of the composition of the reference. (In re Peterson, 315 F.3d 1326, 1330 (Fed. Cir. 2003); In re Boesch, 617 F.2nd 272, 276 (CCPA 1980). Buck et al. claim improved high temperature flow resistance, low temperature break resistance, flexibility, viscosity and percent recovery in column 2, lines 1-11. In the same place a vinyl content of "at least about 25 percent" is specified. Both "at least about 25 percent" of Buck et al. and "about 25 mole% " include 24%, making applicants' claimed range obvious. One of skilled in the art would have expected them to have the same properties. See Titanium Metals v. Banner 227 USPQ 773 (Fed. Cir. 1985). Kalkanoglu recites the addition of fillers (calcium carbonate) to a bitumen/polymer blend in claim 6. Fensel et al. claim a composite having strength and performance comparable to fiberglass yarn, but at a much lower cost (column 2, lines 8-11). Drieskens et al. recite roofing panels which are watertight made of asphalt/block copolymer blend (column 4, lines 1-21. Stephens et al. reveal roofing felts (paragraph 0003), made from a blend of a controlled distribution block copolymer and bitumen having excellent compatibility with bitumen (paragraph 0013) and having a vinyl content of "about 20 to about 80 mol" percent (paragraph 0038), which encompasses applicants claimed range making it patently obvious. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the compositions of the primary references, with the ingredients of the secondary references in order to achieve the properties claimed by said secondary references.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 6:10 a.m.-4:40 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Szekely/
Primary Examiner, Art Unit 1796

/P. S./
Primary Examiner, Art Unit 1796
4/2/09